



Patent
Attorney's Docket No. 003300-581

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
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Thomas BRODIN et al.) Group Art Unit: 1627
)
Application No.: 09/365,241) Examiner: T. Wessendorf
)
Filed: July 30, 1999)
)
For: IN SITU IDENTIFICATION OF)
TARGET STRUCTURES E.G. IN)
VIVO SELECTION METHOD FOR)
A PHAGE LIBRARY)

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Restriction Requirement set forth in the Official Communication mailed on June 14, 2000 (Paper No. 9) and the Interview Summary dated August 23, 2000 (Paper No. 11), Applicants hereby elect with traverse the claims of Group I (Claims 1-57), which are drawn to a method of acquiring binding structures against a target structure.

Applicants further elect with traverse species 1 (monoclonal antibodies) of Group A - Binding Structures. Claims 1-57 are believed to read upon the elected species.

Applicants further elect with traverse species 2 (pathological) of Group B - Process. Claims 1-23 and 28-57 are believed to read upon the elected species. Applicants also elect with traverse the subspecies "tumor deposits" given the election of "pathological" for Group B. Claims 1-23 and 28-57 are believed to read upon the elected subspecies.

Applicants further elect with traverse species 1 (antigen) of Group C - Target.

Claims 1-57 are believed to read upon elected species. Applicants also elect the subspecies "protein" given the election of "antigen" for Group C. Claims 1-57 are believed to read upon the elected subspecies.

Applicants further elect with traverse species 1 (bacterial cells) of Group D - Synthesis. Claims 1-57 are believed to read upon the elected species.

Applicants thank the Examiner for her time in clarifying the Restriction and for preparing and faxing a copy of the Interview Summary which further describes the restriction set forth in Paper No. 9.

M.P.E.P. § 803 states that an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if the restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a restriction should not be made unless there is an undue burden on the Examiner to examine all of the claims in a single application.

Although the Examiner has alleged different classifications for the inventions of Group I (Claims 1-57) and Group II (Claims 58-60 drawn to binding structures), it would seem that a search and examination involved for the two groups of the invention would substantially overlap. For example, the elected method of acquiring binding structures against a target structure of Group I involves the identification of binding structures. The non-elected invention of Group II (Claims 58-60) is drawn to the binding structures identified by the methods of claims 1-58. As overlapping subject matter between the

elected and the non-elected inventions exists, so too exists an apparent overlap in search and examination. Accordingly, a serious burden would not be imposed on the Examiner to examine all the claims of Groups I and II in a single application. Thus, the restriction is improper and should appropriately be withdrawn.

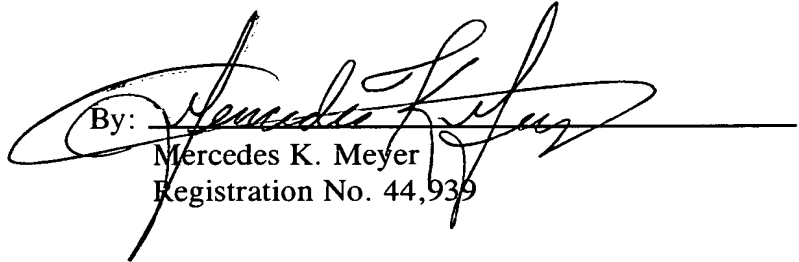
Regarding the election of species requirement, the Office has the burden to show that the generic claim encompasses an unreasonable number of species and that an unduly extensive and burdensome search is required. M.P.E.P. § 801(a). No such showing was presented in the Office Action. Applicants thus traverse the election of species, based on an improper election which fails to meet the requirements of 37 C.F.R. § 1.141 by not explaining the reasoning of why such a search would be burdensome. Moreover, Applicants assert that a search of all species at once would not impose a serious burden on the Examiner.

Accordingly, for at least all of the reasons set forth above, withdrawal of the requirement for restriction and the requirements for election of species requested and believed to be in order. Further and favorable consideration of all the claims of record on the merits is respectfully requested.

In the event that there are any questions relating to this Reply to Restriction Requirement, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Mercedes K. Meyer
Registration No. 44,939

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

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